



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

The application of

Docket No: Q65782

Ikuo SAKAGUCHI

Appln. No.: 09/923,536

Group Art Unit: 2876

Confirmation No.: 2109

Examiner: Edwyn Labaze

Filed: August 8, 2001

For: CARD VERIFICATION SYSTEM AND CARD VERIFICATION METHOD

**INFORMATION DISCLOSURE STATEMENT
UNDER 37 C.F.R. §§ 1.97 and 1.98**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the duty of disclosure under 37 C.F.R. § 1.56, Applicant hereby notifies the U.S. Patent and Trademark Office of the document which is listed on the attached PTO/SB/08 A & B (modified) form and/or listed herein and which the Examiner may deem material to patentability of the claims of the above-identified application.

1. Chinese Patent Application No. CN 1113368A, published December 13, 1995.

One copy of listed document is submitted herewith.

The present Information Disclosure Statement is being filed after the later of three months from the application's filing date and the mailing date of the first Office Action on the merits, but before a Final Office Action, Notice of Allowance, or an action that otherwise closes prosecution in the application (whichever is earlier), and therefore Applicant is filing

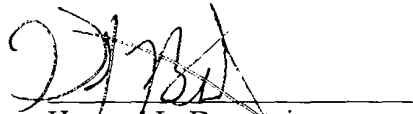
I. SAKAGUCHI
Appln. No. 09/923,536
INFORMATION DISCLOSURE STATEMENT

concurrently herewith a Statement Under 37 C.F.R. § 1.97(e). No fee under 37 C.F.R. § 1.17(p) is required.

In compliance with the concise explanation requirement under 37 C.F.R. § 1.98(a)(3) for foreign language documents, Applicant encloses herewith a copy of an English translation of a Chinese Office Action dated May 9, 2003.

The submission of the listed document is not intended as an admission that any such document constitutes prior art against the claims of the present application. Applicant does not waive any right to take any action that would be appropriate to antedate or otherwise remove any listed document as a competent reference against the claims of the present application.

Respectfully submitted,


Howard L. Bernstein
Registration No. 25,665

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WASHINGTON OFFICE



23373

PATENT TRADEMARK OFFICE

Date: July 3, 2003



Substitute for Form 'i449 A & B/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)		<i>Complete if Known</i>			
		Application Number	09/923,536		
		Confirmation Number	2109		
		Filing Date	August 08, 2001		
		First Named Inventor	Ikuo SAKAGUCHI		
		Art Unit	2876		
		Examiner Name	Edwyn Labaze		
Sheet	1	of	1	Attorney Docket Number	Q65782

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document
		Number	Kind Code ² (if known)		
		US			
		US			
		US			
		US			
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		US			
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		US			

FOREIGN PATENT DOCUMENTS							
Examiner Initials*	Cite No. ¹	Foreign Patent Document			Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Translation ⁶
		Country Code ³	Number ⁴	Kind Code ⁵ (if known)			
		CN	1113368	A	12-13-1995		No

OTHER ART - NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city, and/or country where published.	Translation ⁶

Examiner Signature		Date Considered	
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Applicant's unique citation designation number (optional). ²See Kind Codes of USPTO Patent Documents at www.uspto.gov, MPEP 901.04 or in the comment box of this document. ³Enter Office that issued the document, by the two-letter code (WIPO Standard ST. 3). ⁴For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶Applicant is to indicate here if English language Translation is attached.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

In re application of

Docket No: Q65782

Ikuo SAKAGUCHI

Appln. No.: 09/923,536

Group Art Unit: 2876

Confirmation No.: 2109

Examiner: Edwyn Labaze

Filed: August 08, 2001

For: CARD VERIFICATION SYSTEM AND CARD VERIFICATION METHOD

STATEMENT UNDER 37 C.F.R. § 1.97(e)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The undersigned hereby states, upon information and belief:

That each item of information contained in the Information Disclosure Statement filed concurrently herewith was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of said Information Disclosure Statement.

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WASHINGTON OFFICE

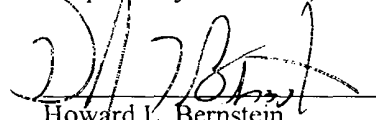


23373

PATENT TRADEMARK OFFICE

Date: July 3, 2003

Respectfully submitted,


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State Intellectual Property Office of People's Republic of China

Add:16/F,ZhongkeBuilding,No.80,Haidian Road, Haidian District, Beijing ,P.R.China Postal Code:100080

Applicant(s)	NEC Corporation	Issuing Date: May 9,2003
Patent Agent(s)	戎志敏	
Application No.	01123878.X	
Title of Invention	Card Verification System and Card Verification Method	

THE FIRST OFFICE ACTION

1. ☒ The applicant has filed a request for substantive examination on _____ (day/month/year). The examiner has proceeded the substantive examination on the above mentioned patent application for invention in accordance with the provisions of Article 35(1) of the Chinese Patent Law.
- ☐ The Patent Office has decided to proceed a substantive examination on the above mentioned patent application for invention in accordance with the provisions of Article 35(2) of the Chinese Patent Law.
2. ☒ The applicant claimed:
- the filing date 2000.8.10 in the Japan Patent Office as the priority date,
- the filing date _____ in the _____ Patent Office as the priority date,
- the filing date _____ in the _____ Patent Office as the priority date,
- the filing date _____ in the _____ Patent Office as the priority date,
- the filing date _____ in the _____ Patent Office as the priority date.
- ☒ The applicant has provided a copy of the priority documents certified by the Patent Office where the prior application(s) was/were filed.
- ☐ The applicant has not provided a copy of the priority documents certified by the Patent Office where the prior application(s) was/were filed and the priority claim(s) is/are deemed not to have been made in accordance with the provisions of Article 30 of the Chinese Patent Law.
3. ☒ The applicant submitted amendment (s) to the application on 23/10/2001 and on _____ , wherein.
- the amendment (s) submitted on _____ and _____ on _____ are unacceptable,
- because said amendment(s) is/are not in conformity with
- ☐ the provisions of Article 33 of the Chinese Patent Law;
- ☐ the provisions of Rule 51 of the Implementing Regulations of the Chinese Patent Law.
- The detailed reasons for the amendments being unacceptable is described in the text of this Office Action.
4. ☐ The examination is proceeded based on the application documents originally filed.
- ☒ Description:
- Pages 1--9 of original application documents filed on the application date,
- Pages _____ filed on;
- Pages _____ filed on;

☒ Claims:

Pages 1-8 of original application documents filed don the application date,

Pages _____ filed on

Pages _____ filed on

☒ Drawings:

Pages 1 of original application documents filed don the application date,

Pages _____ filed on; Pages _____ filed on;

Pages _____ filed on; Pages _____ filed on;

☒ Abstract: ☐ Filed on the application date; ☐ filed on 23/10/2001

☒ Drawing to the Abstract: ☐ Filed on the application date; ☐ filed on 09/08/2001

5. ☐ This Notification is issued without a search having been conducted.

☐ This Notification is issued with a search having been conducted.

☐ The following reference documents have been cited in this office action(their serial numbers will be referred to in the ensuing examination procedure):

Serial No.	Reference document(Number or Title)	Publication Date (or Filing date of interference patent applications)
1	CN1113368A	19 day 05 month 1995 year
2		day month year
3		day month year
4		day month year

6. The conclusive opinion of the examiner is as follows:

☐ Description:

☐ The subject matter of the application falls into the scope, on which no patent right shall be granted, defined by Article 5 of the Chinese Patent Law.

☐ The description is not in conformity with the provisions of Article 26(3) of the Chinese Patent Law.

☐ The description is not in conformity with the provisions of Rule 18 of the Implementing Regulations of the Chinese Patent Law.

☒ Claims:

☐ Claim _____ falls into the scope, on which no granted patent right shall be granted, provided by Article 25 of the Chinese Patent Law.

☐ Claim _____ is not in conformity with the definition of invention prescribed by Rule 2(1) of the Implementing Regulations of the Chinese Patent Law.

☐ Claim _____ does not possess novelty provided by Article 22(2) of the Chinese Patent Law.

☒ Claim 1-8 does not possess inventiveness provided by Article 22(3) of the Chinese Patent Law.

- ☐ Claim _____ does not possess practical applicability provided by Article 22(4) of the Chinese Patent Law.
- ☐ Claim _____ is not in conformity with the provisions of Article 26(4) of the Chinese Patent Law.
- ☐ Claim _____ is not in conformity with the provisions of Article 31(1) of the Chinese Patent Law.
- ☒ Claim 1-8 is not in conformity with the provisions of Rule 20 to 23 of the Implementing Regulations of the Chinese Patent Law.
- ☐ Claim _____ is not in conformity with the provisions of Article 9 of the Chinese Patent Law.
- ☐ Claim _____ is not in conformity with the provisions of Rule 12(1) of the Implementing Regulations of the Chinese Patent Law.

The detailed analysis for above conclusive opinion is described in the text of this office action.

7. On the basis of the above conclusive opinion, the examiner holds that:
- ☐ The applicant should make amendment in accordance with the requirements described in the text of this office action.
- ☐ The applicant should expound reasons for that the above mentioned patent application can be granted patent right, and make amendments to the specification which is not in conformity with the provisions as described in the text of this office action; otherwise the patent right shall not be granted.
- ☒ The patent application does not possess any substantive contents for which patent right may be granted, if the applicant fails to expound reasons or the reasons expounded are not sufficient, this application will be rejected.
- ☐
8. The applicant shall pay attention to the following matters:
- (1) In accordance with the provisions of Article 37 of the Chinese Patent Law, the applicant shall submit a response within four months from the date of receiving this office action. If the applicant fails to meet the time limit without any justified reason, the application shall be deemed to have been withdrawn.
- (2) The amendment made by the applicant shall be in conformity with the provisions of Article 33 of the Chinese Patent Law. The amendment shall be submitted in duplicate copies and in a format which is in accordance with the relevant provisions of the Examination Manual.
- (3) The applicant's response and/or amended documents shall be mailed or submitted to the Receiving Department of the Chinese Patent Office. The documents which are not mailed or submitted to the Receiving Department do not possess legal effect.
- (4) The applicant and/or his(its) agent shall not come to the Chinese Patent Office to interview with the examiner without an appointment.
9. The text of this office action consists of a total of 4 sheets, and is accompanied by the following annexes:
- ☒ A copy of the cited reference documents consisting of 1 sets and 11 sheets.
- ☐

Detailed Office Action

The application relates to Card Verification System and Card Verification Method. The opinion of examining is as following.

1. Scope of claims 1-8 are not clear and it does not comply with Rule 20 (1) of the Implementing Regulations of the Patent Law.

The following is a quotation of provisions of Rule 20 (1) of the Implementing Regulations of the Patent Law:

The claims shall define clearly and concisely the matter for which protection is sought in terms of the technical features of the invention or utility model.

a. Claim 1 requests to protect a card verification system. But the card is verified at the time recorded in the technical scheme, and skilled person can not determine how to verify the card, that is, the technical scheme is not clear. All of the features are described by the steps of method except 'card' in the claim 1. Product claim should describe devices and connection relationship of various devices. It is not clear how to register card from sentence ' a card in which a card identification code is registered'. And also there is no description in the specification for the 'card identification code', skilled person can not determine the code corresponding which one of a plurality of code in the specification. The skilled person does not know how to obtain

‘existing place of said read unit’ and ‘area corresponding to said card identification code’.

b. There are the same defects in the claims 2-6 because claims 2-6 define the claim 1.

c. There is a description ‘said card identification code’ in the claim 3. But skilled person can not determine the ‘said card identification code’ is ‘card identification code’ in the claim 1 or ‘read unit identification code’ in the claim 2. Therefore claim 3 is not clear.

d. There is no the same recording for the ‘storage unit’ in the specification. Skilled person can not determine the storage unit corresponds to which one of a plurality of the table, database and register.

e. There is an additional feature ‘further comprising a mobile phone’ in the claim 5. Skilled person can not determine the ‘mobile phone’ is another mobile phone or mobile phone in the claim 3 since claim 5 indirectly defines the claim 3. The feature of claim 5 repeats the feature of claim 3 if the mobile phone’ is ‘mobile phone in the claim 3.

f. Claim 7 requests to protect a card verification method using a card verification system. There is a description of various parts of card in the preamble portion of claim 7. It makes the claim 7 unclear. There is no the same description for the ‘recorder’ in the specification. skilled person can not determine the ‘recorder’ corresponds which one of a plurality of table,

database and register, and connection relationship between recorder and other devices. The step 'acquiring from said card, an existing place of said read unit which read said card' is not clear. 'The existing place of said read unit' is not stored in the card. So how to acquire existing place of said read unit from card. And also skilled person can not determine how to acquire said area from recorder and what kind of device is used. What kind of device will be used to determine whether said place is in said area.

2. Claims 1-8 do not possess inventive step although applicant may amend the defects of claims 1-8 based on the above examining opinion.

a. Claim 1 requests to protect a card verification system. However reference 1 discloses a non-cash payment securely method and system, in which disclosing following technical features:

Credit card (corresponding to the a card in which a card identification code is registered in the claim 1);

Settlement generator (corresponding to the read unit) for reading an information of credit card;

Computer counting system (corresponding to verification apparatus) for verifying whether credit card is valid or not when credit card implemented in the transaction.

The difference between claim 1 and reference 1 is that a verification apparatus verifies the card only when an existing place of the read unit is

within an area corresponding to the card identification code. But the technical feature is well known knowledge in the field. For example, when mobile phone is used in the other province, verification apparatus verifies SIM card in the mobile phone only when an existing place of the SIM card is within an area corresponding to the card identification code. Thus claim 1 does not possess inventive step compared with reference 1.

b. The technical feature of claim 2 has been disclosed by the reference 1, in which disclosing the following technical features:

Settlement generator having address code corresponding to the existing place of bank or company (corresponding to the read unit identification code of claim 2), the address code being sent to counting receiver (4) via computer counting system (2) which shows address data of credit card.

Above features have disclosed that the system has a table which shows a corresponding relation between address code and existing address. So card holder can identify the settlement information from counting receiver (4). Thus when claim 2 refers to claim 1 that does not possess inventive step, claim 2 does not possess inventive step.

c. Claim 3 further defines mobile phone. However reference 1 discloses a counting receiver (4) (corresponding to the mobile phone of claim 3). Credit card has a corresponding relation with counting receiver (4) though computer counting system (2) has no the table. However it is obvious for

those skilled person in the art to make a table which shows corresponding relation between card identification code and mobile phone. Thus when claim 3 refers to claims 1 or 2 that do not possess inventive step, claim 3 does not possess inventive step.

d. The technical feature of claim 4 has been disclosed by the reference 1, in which disclosing the following technical features:

Individual cipher database 4d is stored in the counting receiver (4), that means the system has a memory. Computer counting system (2) obtains the information whether the settlement passing via reaction of card holder. Thus when claim 4 refers to claims 1 or 2 that do not possess inventive step, claim 4 does not possess inventive step.

e. The technical feature of claim 5 belongs to the common knowledge. When mobile phone move out local town, cruise data is stored in the memory. When mobile phone came back, the cruise data is deleted. Thus when claim 5 refers to claim 4 that do not possess inventive step, claim 5 does not possess inventive step.

f. The technical feature of claim 6 has been disclosed by the reference 1. Thus when claim 6 refers to claims 1 or 2 that do not possess inventive step, claim 6 does not possess inventive step.

g. Claim 7 requests to protect a card verification method using a card verification system. However reference 1 discloses a non-cash payment

securely method and system, in which disclosing following technical features:

Credit card (corresponding to the a card in which a card identification code is registered in the claim 1);

Settlement generator (corresponding to the read unit) for reading an information of credit card;

Computer counting system (corresponding to verification apparatus) for verifying whether credit card is valid or not when credit card implemented in the transaction.

The using method of the system is:

Inserting credit card;

Computer counting system of bank is started-up;

Settlement signal is transmitted to the counting receiver of cardholder via wireless signal;

Cardholder determines whether settlement data is valid, if the settlement data is not valid, settlement generator refuses the transaction.

The difference between claim 7 and reference 1 is that a verification apparatus verifies the card only when an existing place of the read unit is within an area corresponding to the card identification code. But the technical feature is well known knowledge in the field. Thus claim 7 does not possess inventive step compared with reference 1.

h. The technical feature of claim 8 is well known knowledge in the field. For example, when mobile phone is used in the other province, verification apparatus verifies SIM card in the mobile phone. If there is no recording of the SIM card in the area, prohibiting the settlement. Thus when claim 8 refers to claim 7 that does not possess inventive step, claim 8 does not possess inventive step.

The following is a quotation of article 22 (3) of the Patent Law:

Inventiveness means that, as compared with the technology existing before the date of filing, the invention has prominent substantive features and represents a notable progress and that the utility model has substantive feature and represents progress.

Based on the above reasons, this application shall not be issued now and also the application has no perspective to obtain a patent. If applicant can not describe the inventive step according to original specification and claims, or amend the claims to overcome the objection, the application will be rejected according to patent law.

It is noted that the amendment shall not go beyond the scope of the specification according to the Article 33 of the Chinese Patent Law.